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In re Application of
ASANO, et al.

U.S. Application No.: 09/856,717

PCT No.: PCT/JP99/06617

Int. Filing Date: 26 November 1999

Priority Date: 27 November 1998

Attorney Docket No.: 0230-0162P

For: T CELL IMMUNOACTIVITY ENHANCERS
CONTAINING EXTRACT OF LENTINUS
EDODES MYCELIUM

DECISION ON PETITION

UNDER 37 CFR 1.47(a)

This decision is in response to the applicant's "PETITION UNDER 37 C.F.R. § 1.47(a)" filed 19 February 2002 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 26 November 1999, applicant filed international application PCT/JP99/06617 which claimed priority to an earlier application filed 27 November 1998. The thirty-month period for paying the basic national fee in the United States expired at midnight on 27 May 2001.

On 25 May 2003, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by the requisite basic national fee; a translation of the international application into English and First Preliminary Amendment.

On 19 July 2001, applicant was mailed a "Notification of Missing Requirements" (Form PCT/DO/EO/905) informing applicant that an executed oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required. Applicant was afforded two months to file the required response.

On 19 February 2002, applicant filed the present petition under 37 CFR 1.47(a) to accept the filed declaration without the signature of joint inventor Yutaka TAJIMA accompanied by a petition for a five-month extension of time.

On 16 April 2002, applicant was mailed a "Notice of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495."

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the requisite \$130 petition fee required by 37 CFR 1.17(I); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing joint inventor; and (4) an oath or declaration executed by each of the signing joint inventors on their behalf and on behalf of the non-signing joint inventor(s). Applicant has satisfied items (1), (3) and (4) above.

Regarding item (2), Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP) states, in part:

Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature."

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47. Such a petition will be dismissed as inappropriate.

The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

Presently, applicant has merely provided a statement from counsel that the "non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with same." Pursuant to 37 CFR 1.47(a) applicant is required to show that an attempt has been made to present the non-signing inventor with a complete set of application papers and declaration for national stage entry. In addition, applicant has not provided any information as to "diligent effort" such as whether a search of telephone directories or Internet search engines were performed in an attempt to find a current address for

inventor TAJIMA .

In light of the above it is not possible to grant applicant's petition under 37 CFR 1.47(a) at this time.

CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(a) is **DISMISSED without prejudice**.

The "Notice of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495" is hereby **VACATED**.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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